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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

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4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/560,836

Applicant(s)

GROSSMAN, JAMES

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### Detailed Action

### Examiner's Note

1. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all references passages as potentially teaching all or part of the claimed inventions.

### *Claim Rejections - 35 U.S.C. § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

#### Examiner's Note:

Hereinafter, "Motivation to combine.." stands for "Therefore it would have been obvious to one having ordinary skill in the art, at the time of Applicants' invention was made, to combine ( the previously cited reference) to (the presently cited reference) ..."

**3. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clevensine, , US 6053536 hereinafter Clevensine in view of Sparks et al. US 6167382.**

Clevensine discloses:

1. A method of distributing to a plurality of independent users, paper sheets, each sheet having at least one free field and bearing advertising messages sponsored by one or more advertisers that are unrelated to the users of the paper sheets, the method comprising the steps of:
  - a. providing a plurality of paper sheets having a per unit acquisition cost;

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- b. printing one or more advertisements on the plurality of printable paper sheets and leaving a printable field free of printed advertising on each of the plurality of sheets;( col 3l. 29-40) and
- d. distributing the wrapped packs of partially-printed paper to a plurality of users. (Fig 3-4 and associated text).

Clevenstine does not specifically disclose the papers are printable however discloses the mailers as used in mass mailings ( col 3 l. 47-55). Since printing content for mass mailings is known therefore it would be obvious content printing would have been added to the teachings of Clevenstine to efficiently effect mass mailings. Note further printing by individual printers is technologically known by Applicant's invention time, see e.g. Golden, US 5761648, Fig 1, therefore it's obvious that printable papers be added to Clevenstine to allow small business mailer users to print their content.

Further as stacking and wrapping a predetermined number of the partially-printed paper sheets to form packs of paper is a conventional distribution method, it's obvious to be added to Clevenstine to effect Clevenstine selling to users scheme.

- 2. Clevenstine suggests the packs of paper are distributed to the plurality of users through conventional retail channels of trade. ( col 3l. 29-40, "sold")
- 3. Clevenstine does not specifically disclose compiling a mailing list from a user database(col 3 last para. to col 4 1<sup>st</sup> para.) that is comprised of user identifying information for each of the plurality of users; and distributing the packaged paper directly to the users on the mailing list based on each of the respective user's identifying information., however such method is conventionally known to directly sold to users thus obvious to add to Clevenstine to effect selling as taught.

4 (dependent on claim3)

Clevenstine implicitly discloses

entering one or more advertising identification indicia in association with the user identifying information in the user database (col 3 last para. to col 4 1<sup>st</sup> para.) ; and distributing to each of the plurality of users packaged paper bearing advertising corresponding to at least one of the advertising identifying indicia associated with each of the plurality of users (col 4) .

(use of indicias to associate with particular ads is known and obvious; identification of ads and users and their respective correlation is implied in Clevenstine.

5.(dependent on claim 4)

*("advertising identification indicia" is not defined in the specifications. Therefore the Examiner interprets it as "user-related information", such as an address, or an identification of the user who is a target of the advertisement, based on claim 4 in which "advertising identification indicia" is used in the phrase "advertising identification indicia in association with the user identifying information". )*

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Printing users' addresses or other identification ( advertising identification indicia) on the exterior of the product to be shipped to the users is well-known thus it would be obvious to have such indicia printed on the exterior of the packs of paper to be sold (taught by Clevenstine) and shipped to users.

6. (dependent on claim 3)

Clevenstine does not but Sparks (Fig. 1 and associated text) discloses providing an interactive website on the worldwide computer network for receiving user identifying information; and receiving and storing user identification information transmitted by a plurality of users from remote computer terminals in the user database.(abstract, Fig 1-13 and associated text). Motivation to combine: to use computer and Internet method efficiencies to do the ad targeting taught by Clevenstine at col. 4.

7.(dependent on claim 6 )

Sparks discloses: displaying a menu of advertising identification indicia and associated advertising identification information; and receiving and storing advertising identification indicia selected by an online user in association with the user identifying information for each user. (abstract, Fig 1-13 and associated text). While Clevenstine discloses correlation of chosen ads to mailers users (col 4) thus it'd be obvious Sparks method is added to Clevenstine to take advantage of known technology to carry out Clevenstine's teaching more efficiently.

8. (dependent on claim 2)

Clevenstine discloses receiving payment for the pack of paper from users, where the amount of the payment is less than the cumulative acquisition cost of the number of paper sheets in the pack. (col 3 l. 35-40)

9. (dependent on claim 1) where the packs of paper are distributed to users without charge is obvious to add to Clevenstine if the subsidization as taught by Clevenstine is designed to be 100%. Such total discount is well-known to have been done.

10. Clevenstine discloses the partially-printed sheets have a central printable field and the one or more advertisements are printed in at least one marginal area (Fig 3 and associated text) .

**4. Claims 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clevenstine in view of Sparks.**

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11. A method of distributing printed advertising via the Internet to online Internet users comprising the steps of:
- a. establishing an Internet website for receiving user identifying information;
  - b. receiving and storing user identifying information transmitted by a plurality of users from remote computer terminals to thereby constitute a database of registered users;
  - c. transmitting to registered users a printable credit device redeemable for the purchase of goods and/or services; and
  - d. thereafter electronically transmitting to registered users advertising information that is formatted for marginal printing on printable paper sheets by the registered user's printer when the registered user downloads printed information via the Internet.

Subsidized preprinted with ads/coupons mailer sheets are taught by Clevenstine. Customized assembly of the mail piece via Internet with layout template control is taught by Sparks therefore it would be obvious to incorporate the Sparks Internet document assembly into the Clevenstine to use Internet efficiencies.

Further, Clevenstine discloses subsidized mailings (i.e. each mailer costs the subsidizers so much) , while subsidies given in terms of purchase credits is known, therefore it would be obvious to add such subsidies into the Clevenstine method if the user had paid for the sheets in full and the subsidy is to be given out as purchase credits later.

Claim 12. (dependent on 11) Clevenstine discloses subsidized mailings (col 3 l. 35-40: i.e. each mailer costs the subsidizers so much) thus maintaining a record of the number of paper sheets on which advertising is marginally printed in association with each registered user's identifying information is obvious to add to Clevenstine's subsidized mailers teaching, to account for the subsidy to be given if the electronic method of subsidy is to be used. Such accounting methods are known.

Further subsidies in terms of purchase credits is known. Payment after a certain accrued benefit has been rendered , for accounting convenience, is also known. Thus, transmitting to the user a printable credit device that is redeemable for the acquisition of goods and/or services when a predetermined number of paper sheets containing marginal advertising have been printed, would have been obvious to efficiently effect payment of subsidy as taught by Clevenstine.

Further transmitting to the user of the subsidy (purchase credits) via the registered user's e-mail address is known as another efficient payment method therefore obvious to add to Clevenstine and Sparks.

13. (dependent on 12) where printed credit device is redeemable for the acquisition of printable paper sheets would be obvious as a subsidy method if the ads distributor and mailer distributor are affiliated as suggested in Clevenstine.

14. (dependent on 11)

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Clevenstine discloses selective matching of ad categories by the mailer user ( col 4 1<sup>st</sup> para.) and Sparks discloses customized assembly thus :  
transmitting to registered users indicia identifying a plurality of categories of products and services for which printed advertising is available; and  
storing any indicia in response to a selection transmitted to the website by a registered user indicating a registered user's preference for advertising of one or more categories of products and/or services.  
would have been obvious to add as efficient assembly /tracking methods.

Claim 15:

Clevenstine and Sparks, in view of known personal computer printing, disclose, as stated above (Clevenstine discloses partially preprinted sheets. Sparks discloses personalized print orders via Internet.):

A method of distributing personalized printed advertising via the Internet to a plurality of online Internet users comprising the steps of:

- a. distributing a plurality of uniform partially-printed sheets comprising printed fields of advertising and/or informational text and fields of open spaces for receiving personalized printed text, said printed sheets being of a size and quality for use as a printable medium in a computer-directed printer;
- c. establishing a sponsor's interactive Internet website for receiving user identifying information;
- d. receiving and storing user identifying information transmitted by a plurality of users from remote computer terminals to thereby constitute a database of registered users and associated registered user information (suggested by Clevenstine; and also in Sparks)
- e. transmitting via the Internet to one of the plurality of registered users upon the registered user's request, personalized information that is formatted for printing to complete one or more of the fields of open spaces on one of the plurality of uniform partially-printed sheets in the registered user's computer-directed printer.

Also Sparks discloses:

- b. maintaining a relational database of information that is related to the printed fields of advertising and the fields of open spaces on the uniform partially-printed sheets (This feature is also implicit in Clevenstine in order to produce the partially preprinted mailers);

(Sparks :

*"In response to a browse command or other request from a client, the client will be presented with a list of templates that are suitable for placement in the particular page-slot identified by the shell; only certain templates will meet the criteria. In the structure illustrated in FIG. 11, three such templates 166, 168 and 170 are available for the client to select for fitting within the*

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*back page page-slot 164. Unlike a shell or a page-slot, a template is not a purely logical construct but rather is associated with a file. A template has two types of content: static and dynamic. The static contents are fixed parts of the template and it may include images and text. For example, the legal copy on a coupon or the main image on a freestanding insert may be "static" content associated with the template. The dynamic content of a template is associated with the template's slots. A template may contain zero to several "slots". From the database's perspective, a template with no slots is essentially an image. Templates are the essential dynamic component of the image catalog. A template is a piece of partially completed artwork that is finished when the client chooses contents for the empty portions of the template, which are the template's slots." .... )*

Thus motivation to combine those embodiments of Sparks and Clevenstine: if a mail user desires to print personalized content only, having pre-chosen the template, the template could be pre-printed and thereby save the mailer user an extra document assembly step.

16. (dependent on claim15)

Clevenstine discloses the partially-printed sheets are selected from the group consisting of magazine and newspaper inserts, magazine pages, direct mail inserts and letter sheets, and handbills. (Fig 3 and text: letter sheets).

17. (dependent on claim15)

It is known new products are often advertised as free samples. Therefore it would have been obvious to one skilled in the art to offer samples of the preprinted mailers of Clevenstine in publications of general circulation to start the selling of the mailers. To that combination, Sparks would have been obvious to be added, as stated above to use internet efficiencies. Thus claim 17 would have been obvious to one skilled in the art.

18. (dependent on claim15)

Sparks discloses (Figs.2-5 and associated text)

prompting the registered user to respond to specific inquiries; entering any responses received in the registered user's personalized database; and processing the information in the registered user's personalized database in order to provide the personalized information to complete the one or more open fields for transmittal to the registered user.



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19. (dependent on claim 15)

Sparks suggests (e.g. abstract, last sentence) transmitting images of at least a portion of the partially-printed sheet that has been completed with the personalized information for display on a monitor employed by the registered user to access the sponsor's website. Transmitting a fax would have been obvious as a substitute to the above teaching of Sparks, to add choices, per customer desire or convenience.

**5. Claims 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden US 5761648.**

Claim 20.

Golden discloses:

A method of distributing prescribed printed copy via the worldwide web to authorized registered users, the method comprising the steps of:

- a. providing a website from which the prescribed printed copy (Fig 1 and associated text; col 4 l 20-24) can be transmitted to registered users;
- c. providing the user with a registered authorization indicia (Fig. 2 and associated text) ;
- d. maintaining an authorized registered user database comprising user identifying information for the purchaser of the one or more printable paper sheets and the authorization indicia;
- e. transmitting the prescribed printed copy for printing by the user in response to a validated request from an authorized registered user; and
- f. updating the database of authorized registered users to indicate the transmission of the prescribed printed copy as a completed transaction (Fig 8 and associated text) .

As to

- b. selling one or more paper sheets to a user, it is implicit that the Golden user has to buy paper sheets from some seller.

Golden does not specifically mention the worldwide web but discloses on line systems and by the time of Applicant's invention the worldwide web is a ubiquitous and the skilled artisan would have known to apply the worldwide web as another network to effect the teachings of Golden on such popular and effective medium of communications.

21.(dependent on claim 20 )

Golden discloses:

the prescribed printed copy is selected from the group consisting of photographic images, facsimile autographs, printed text, and combinations thereof.

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Claims 22 and 23. (dependent on claim 20) where the prescribed printed copy is selected from periodically issued reports in the fields of the arts and sciences, business and technology, literary texts, pictorial works, and combinations thereof is known

And where the one or more printable paper sheets are sold in sealed packages is known and obvious to add to Golden because it's standard business practice.

Further the authorization indicia on a purchase item used as a means of proof of payment and to access a software value on a network is known. Thus " the authorization indicia being accessible only after the sealed package is opened" would be obvious to add to Golden teachings in view of such known art in lieu of paying on-line, or payment by some other method.

24. (dependent on claim 20 )

That the one or more printable paper sheets are provided with pre-printed fields prior to the sale to the user, where the pre-printed fields relate to the prescribed printed copy to be printed thereon is known. Such would be the situation of travel agencies, for example, who buy their tickets forms pre-printed with for example their agency logo preprinted thereon. In printing out tickets for customers, using the system of Golden, the pre-printed fields (company logo, addresses) relates to the prescribed printed copy to be printed (the ticket which is issued by such and such travel agency) .

Another example would be pre-printed billing forms (or purchasing order forms) with identifying indicia of the sender, unique number for the form, which is used to bill /purchase order by accessing on-line data. Such forms are known to have to be purchased as well.

25, 26,28. (dependent on claim 20 )

As stated in claim 24 above, the pre-printed billing/purchase order forms are known to have the following:

- each of the one or more printable paper sheets on which the prescribed printed copy is printed by the user bears a unique identifying indicia, (at least numbers)

- the unique identifying indicia is selected from the group consisting of numbers, letters, symbols, and combinations thereof; and

- one or more printable paper sheets are sold at a retail store ("sold").

27. (dependent on claim 22 )

Golden teaches registered authorization indicia, received over the network (fig 4 item 59 and associated text) , entitles the user to receive prescribed printed copies (abstract, last 2 lines) .

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29. (dependent on claim 24)

Golden ( Fig 5-8 and text; col 3 l 65-col 3 l. 26) in view of the known use of pre-printed forms by event tickets issuers such as travel agents as discussed above, disclose the one or more paper sheets are partially-printed admission tickets and the prescribed printed copy transmitted for printing by the user completes the ticket.

**6. Claims 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clevenstine , Sparks and/or Golden in view of known computer and printer control technologies.**

Sparks and/or Golden in view of known computer technologies, at least implicitly disclose claim 30 a-c, 34-37 because the ancillary programmable printer control means claimed in claim 30 a-c, 34-37 are known to the skilled in the art.

Further, the methods of claims

31. (dependent on claim 30) in which the ancillary printer control means is programmable to print a plurality of different advertising messages.

32. (dependent on claim 30) in which the ancillary printer control means is programmable to print advertising messages from a plurality of different sponsors.

are obvious to one skilled in the art based on Clevenstine in view of such known printer control techniques.

The method of claim

33. (dependent on claim 30) in which the ancillary printer control means is programmable to print at least one different advertising message on a plurality of sequentially printed sheets is at least suggested by Golden in view of such known printer control techniques.

**7. Claims 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sparks in view of Golden.**

As to Claim 38,

A method of providing a plurality of interchangeable printed display inserts for use with a display item, where the display item has at least one pocket for removably receiving at least one corresponding display insert, the method comprising:

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- a. establishing a website on the Internet worldwide computer network;
- b. assigning to the display item a unique identifying indicia;
- c. providing a design database comprising a plurality of printable designs configured for printing in a format corresponding to at least one display insert for the at least one display item;
- d. providing means for transmitting via the Internet at least one of the plurality of printable designs from the database in response to a request accompanied by the unique identifying indicia for the display item.

Use of interchangeable printed display inserts with a display item, where the display item has at least one pocket for removably receiving at least one corresponding display insert is known.

Use of unique identifying indicia on items as proof of purchase and to allow access to a software value/service on a network based on such indicia is known.

Customized document (display items) assembly on the web is taught by Sparks (Figs. 3-4, 4a, 12a, 25-27, 35-36 and associated text).

Printing at a remote computer is known (e.g. Golden).

Therefore the steps of claim 38 would be obvious.

Motivation to combine : to take advantage of network efficiencies to let the users produce their targeted content, as taught in Sparks, in the context of display ads.

Since the display ads with inserts are known, since the inserts are known to have to be modified periodically with new products/services, and since a way of charging for the service of providing the ads templates/content over the network is known (Sparks) and since further charging by selling an item with authorization indicia for network service is known, the skilled artisan would have known to add all those known techniques and marketing/business purposes to arrive at claim 38.

39. (dependent on claim 38)

Sparks in view of known techniques and marketing/business purposes state above further discloses:

- a. providing a user database for receiving and storing user identifying information corresponding to purchasers of the display item;
- b. providing a purchaser of a display item with a unique access code corresponding to the display item purchased.
- c. transmitting at least one of the plurality of printable designs in response to a request accompanied by the unique access code.

### ***Objection to Specifications***

- 8. The abstract is missing. Appropriate correction is required.

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### Conclusion

9. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Farros, US 5930810, discloses printing system with pre-defined user modifiable forms and local and remote printing. Farros could be used to reject at least claims 20-22.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

KHL

March 19, 2003

KHL

*Steve Gravini for us*

STEPHEN GRAVINI  
PRIMARY EXAMINER